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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,990	10/30/2003	Stephen J. Orr	91922-7	5665

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EXAMINER

CHAN, WING F

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/695,990	<b>Applicant(s)</b> ORR, STEPHEN J.	
	<b>Examiner</b> Wing F. Chan	<b>Art Unit</b> 2643	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

1. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 is a single step claim, e.g. the claim recited "adjusting an appearance of said video image...conference participants", which is a single step recitation that does not appear in combination with another recited step, and thus encompasses all possible conceivable means for performing a stated function. It is a claim that depends on a recited property, a factual situation comparable to Hyatt, where the claim covers every conceivable step for achieving the stated property (result) while the specification discloses at most only those known to the inventor. Therefore, the specification is non-enabling for failing to disclose all possible steps for performing the stated function. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21, 22, 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21, 22, 24 are vague and indefinite in that what is meant by the term "adapts", "adapting".

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6, 8-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Strubbe (US PAT. NO. 6,473,114).

Strubbe discloses a conference system in which the appearance of a video image of one of two other participants is adjusted in dependence on a level of activity associated with one of two other participants. In Strubbe, the activity is the determination of a current active speaker which is constantly and repeatedly changing, for example see all figures, abstract, col. 1 line 64 to col. 4 line 18. Strubbe also discloses the image can be any practicable size (e.g. col. 2 lines 3-5).

6. Claims 1-6, 8-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton (US PAT. NO. 5,914,747).

Hamilton discloses a conference system in which the appearance of a video image of one of two other participants is adjusted in dependence on a level of activity associated with one of two other participants. In Hamilton, the activity level reads on

the determination of activity at a given site (e.g. presence or absence, in front of station or not) which is constantly and repeatedly changing, for example see all figures, abstract. Hamilton also discloses the image from the present site is transmitted and no image is transmitted from a site in which the participant is determined to be absent, thus adjusting the image and the GUI. See all figures, col. 1 line 56 to col. 3 line 13.

7. Claims 1-6, 8-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Nimri et al (US PAT. NO. 6,744,460 hereinafter Nimri).

Nimri discloses a conference system in which the appearance of a video image of one of two other participants is adjusted in dependence on a level of activity associated with one of two other participants. In Nimri, the activity is the determination of a current active speaker which is constantly and repeatedly changing, for example see all figures, abstract, col. 2 line 1 to col. 7 line 63. Nimri also discloses the image can be any practicable size, e.g. single window, single speaker presentation mode, multiple window, multiple speaker discussion mode.

8. Claims 1-6, 8-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen-Solal et al (US PAT. NO. 6,674,458 hereinafter Cohen-Solal).

Cohen-Solal discloses a conference system in which the appearance of a video image of one of two other participants is adjusted in dependence on a level of activity associated with one of two other participants. In Cohen-Solal, the activity level reads on the determination of activity at a given site (e.g. see col. 2 line 60 to col. 3 line 13) which

is constantly and repeatedly changing, for example see all figures, abstract. Cohen-Solal also discloses the image can be any of the live mode or representative mode. See col. 3 line 14 to col. 8 line 33.

9. Claims 1-6, 8-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferren et al (US PAT. NO. 6,812,956 hereinafter Ferren).

Ferren discloses a conference system in which the appearance of a video image of one of two other participants is adjusted in dependence on a level of activity associated with one of two other participants. In Ferren, the activity is based on descriptive information received from sensors at each site, which is constantly and repeatedly changing, for example see all figures, abstract, col. 3 line 7-18, 33 to col. 15 line 40. Ferren also discloses the image can be any practicable size, e.g. single image, composite image, wide-angle views, etc., e.g. see col. 3 lines 45-54, col. 7 lines 21-25.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over anyone of Strubbe, Nimri, Cohen-Solal, Hamilton, or Ferren in view of Hein et al (US PAT. NO. 6,466,250 hereinafter Hein).

Hein discloses that it is old and well known in the art to use highlighting with color to indicate a current speaker [indicate a level of activity] in a conference, for example see Figs. 5-7, col. 4 line 65 to col. 5 line 8, col. 6 line 63 to col. 7 line 22. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to anyone of Strubbe, Nimri, Cohen-Solal, Hamilton, or Ferren to comprise highlighting with color to indicate a current speaker [indicate a level of activity] in a conference, as is old and well known in the art, to direct the attention of the other participants to the current speaker.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US PATS. 6,611,281; 6,535,240.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wing F. Chan whose telephone number is 571-272-7493. The examiner can normally be reached on Monday to Friday from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Wing F. Chan', with a stylized, cursive script.

Wing F. Chan  
Primary Examiner  
Art Unit 2643

2/3/06